REMARKS

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I. Claim Rejecti n – 35 U.S.C. §112

Claim 46 is rejected under 35 U.S.C. §112, first paragraph, as containing subject matter which is not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Specifically, the Examiner states that the specification fails to set forth any working examples to demonstrate the "prevention" of the many different disorders as claimed.

Claim 46 is directed to a method for treating or preventing ***osteoporosis and bone loss***. Contrary to the Examiner's statement, claim 46 is not directed to the prevention of the different disorders recited in that claim, e.g., age, rheumatism, Paget's disease. Rather, claim 46 recites a method for treating or preventing ***osteoporosis and bone loss*** that occurs in disorders or conditions such as age, steroid therapy, rheumatism. Applicants submit that the specification, including the Examples, provide an enabling disclosure of the effectiveness of the claimed invention in preventing ***osteoporosis and bone loss***. In this regard, the Examiner's attention is directed to page 10, lines 27-29 of the specification and the results of the biological evaluation as reported on page 11, lines 1-9, of the specification.

In view of the foregoing, Applicants respectfully submit that the Examiner has misread claim 46. This claim is not directed to the prevention of many different disorders. Rather, claim 46 is directed to the treatment and prevention of ***osteoporosis and bone loss*** which is fully supported by the specification. Accordingly, withdrawal of the §112 rejection is requested.

II. Claim Rejection – 35 U.S.C. §102

Claims 1-4, 19, 23, 25, 27, 29-34 and 39-46 are rejected under 35 U.S.C. §102(e) as being anticipated by WO 88/00829. The cited prior art document WO 88/00829 discloses a composition containing a bisphosphonate and absorption enhancer for ***nasal administration***.

Anticipation requires that each and every feature of the claimed invention be disclosed within the four corners of a single reference. Applicants submit that WO 88/00829 fails as an anticipatory reference for the following reasons.

The claims were amended by the Amendment, filed 17 September 2003, to clarify that the claimed invention is directed to an ***oral pharmaceutical formulation***. There is no disclosure, either expressly or inherently, of such an oral formulation or oral administration by WO 88/00829. Therefore, WO 88/00829 does not disclose each and every feature of the claimed invention.

The same §102 rejection was made in the Office Action, mailed 18 June 2002. Based on the claim amendments, it appears that the §102 rejection was withdrawn since the Examiner did not maintain the §102 rejection in the following Office Action, mailed 26 November 2002.

Therefore, withdrawal of the §102 rejection based on WO 88/00829 is deemed proper in view of the prosecution file history and the comments made herein.

III. Claim Rejection – 35 U.S.C. §103

Claims 5, 10, 11, 15, 16, 20, 22, 24, 26, 28 and 47 are rejected under 35 U.S.C. §103(a) as being unpatentable over WO 88/00829. The Examiner alleges that the reference differs from the claimed invention in the use of the specific additives, i.e., the absorption enhancer. The

Examiner concludes, therefore, that it would have been obvious at the time the claimed invention was made to substitute one absorption enhancer for another to arrive at the claimed invention.

As discussed in Section II, above, the dosage form and administration route of the claimed invention is different from that of the reference. Specifically, the claimed invention is directed to an oral dosage form and a method of oral administration. In contrast, the disclosure of WO 88/00829 is limited to a nasal dosage form and nasal administration of the prior art dosage form. In the absence of impermissible hindsight, there is no meaningful suggestion by WO 88/00829 of an oral dosage form and oral administration of the claimed oral dosage form.

Furthermore, the cited WO 88/00829 and the prior art identified by Applicants in the Information Disclosure Statement, filed 11 October 2001, disclose that the disadvantages associated with the oral administration of bisphosphonates. For example, the following disclosure appears at page 1, lines 13-20 of WO 88/00829:

> Bisphosphonates have hitherto been administered either orally or intravenously to patients. ***However, the oral absorption is poor and often accompanied by gastrointestinal side effects. Furthermore, the degree of absorption shows substantial individual variations.*** Consequently, intravenous administration has up till now had to be used whenever a rapid and reliable delivery of bisphosphonates was needed. (Emphasis added)

Thus, WO 88/00829 represents a "teaching away" from the claimed invention. Having read WO 88/00829, the person of ordinary skill in the art would have been dissuaded from preparing an oral dosage form comprising a bisphosphonate and an absorption enhancer to be administered in the treatment and prevention of osteoporosis and bone loss.

For all of the foregoing reasons, the Examiner has failed to establish a *prima facie* case of obviousness. Withdrawal of the §103 rejection is therefore requested.

CONCLUSION

Applicants submit that pending claims 1-21, 23-34, 40-42 and 45-47 are in condition for allowance, which action is earnestly solicited. The Assistant Commissioner is hereby authorized to charge Deposit Account No. 23-1703 in the event that any fee is required in connection with this communication.

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Respectfully submitted,

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